



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,041	05/04/2001	Herbert Reiners	1113-001PRE/FLS	9078

7590

07/08/2005

Schweitzer Cornman Gross & Bondell
292 Madison Ave. 19th Floor
New York, NY 10017

EXAMINER

CHIN, PAUL T

ART UNIT	PAPER NUMBER
----------	--------------

3652

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,041

Applicant(s)

REINERS ET AL.

Examiner

PAUL T. CHIN

Art Unit

3652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 9-12, 16-20, 23-27 and 29-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6, 7, 9-12, 16-20, 23, 24 and 31-38 is/are allowed.
- 6) ☒ Claim(s) 25-27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 6,138,815 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application. These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Specification

2. The disclosure is objected to because of the following informalities: in the specification of the original patent:

in Col 1, line 3, the word "application" after "This" should be changed to -- [application] and inserted the phrase -- is a reissue of U.S application, Serial No. 09/309,687, now U.S. Pat. No. 6,138,815, which -- after "[application]", and

in the provided amendment C (filed November 10, 2003):

in claim 37, line 25, the word "aid" should be changed to -- [aid] -- and also insert a word -- said -- after "[aid]".

Appropriate correction is required.

3. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

Art Unit: 3652

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Enclosed with this Office action is a sample Statement under 37 CFR 3.73(b) which an assignee may use in order to ensure compliance with the Rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel____, Frame____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:____ To:____" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b).

4. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

It is mandatory that applicant submits a supplementary declaration at the end of the prosecution to cover all the errors corrected (i.e. amendments made) during prosecution. This declaration should have a date of execution later than or concurrent with the date of recent. Note that the residence or mailing address problem (below) could be resolved in the supplementary declaration.

Oath/Declaration does not identify the citizenship of each inventor.

Oath/Declaration does not identify the city and either state or foreign country of residence of each inventor. **The residence information may be provided on either on an application data sheet or supplemental oath or declaration.**

Note that the address beneath each inventor's name appears to be a mailing address, but there is no "residence" provided. If the mailing address and the residence are the same, the declaration should provide such address and make it clear that the address is also the residence.

Art Unit: 3652

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 25-27, 29, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, applicant states the following paragraphs on Col. 2, lines 21-44 of the original patent:

In addition, carts and over the tops of laterally opposed conveyor bands without compromising the safety of the system (lines 21-27 of Col. 2)

and

To this end, the system of the invention, which includes laterally opposed conveyor bands, engageable with the carts on the opposite sides, provides for the conveyor bands to be positioned at the lowest practicable level (see lines 39-44).

However, applicant recites "one or more endless conveyor bands" (Claim 25, lines 2-3) and "wheeled load carrying carts engageable by said one or more conveyor bands" (see also lines 3-4). It is pointed out that applicant *never* discloses, particularly, "one endless conveyor band" engageable with "the carts" in the specification or in the provided drawings of the original application. Moreover, *only* "one conveyor band" would not work well to engage with "the carts" because "laterally opposed conveyor bands" secure the wheels of each cart as described in the specification and also in the drawings.

Art Unit: 3652

7. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b),(c), and (g).

The amendment C, filed November 11, 2003, proposes amendments to the claims that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

Note that the comment below deals only with amendment C since all the claims presented in the amendment B filed March 25, 2003, and the amendment A filed June 19, 2002, have been deleted.

All amendment changes must be made relative to the patent to be reissued. Pursuant to 37 CFR 1.173(d), any such changes which are made to the specification, including the claims, must be shown by employing the following "markings:"

(A) The matter to be omitted (in patented claims) by reissue must be enclosed in square brackets []; and

(B) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (pursuant to 37 CFR 1.96 for computer printouts or programs, and 37 CFR 1.825 for sequence listings). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

37 CFR 1.173 (g) Amendments made relative to the patent. All amendments must be made relative to the original patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

All amendments are made with respect to the original patent which means that all changes to the claims must be shown by the appropriate bracketing and/or underlining. Since there were 24 original patent claims, claims 25-27 and 29-38 should be totally underlined. Deletion in any of claims 25-27 or 29-38 could not be enclosed in square brackets since brackets are only used to denote deletions in patented claims or specification. Deletions from new claims are merely ignored (i.e. the language is not present in the amended claim). Note claim 25 in this regard.

Art Unit: 3652

With respect to 1.173 [c], an amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," etc., should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

For instance,

in claim 1, line 1 (of amendment C), the status of the claim "(currently amended)" should be changed to -- (twice amended)--,

in lines 8-9, the phrase "said wheels being mounted for rotation about axles," should be underlined as "said wheels being mounted for rotation about axles,"

line 14, the word "first" before "wheels" should not be deleted, but provide as -- [first] --,

line 14, the phrase "at one end of said cart" should be underlined, and

lines 18-21, the phrases "separate from and extending to a point below said axles", "and engaging", and said retaining track" should all be underlined.

Applicant is strongly recommended to make sure that all the claims are thoroughly reviewed and edit to comply with the reissue amendment rules.

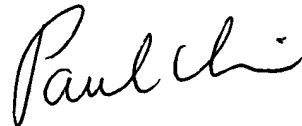
Finally, applicant should provide the status of the claims on pages separate from the claims and also the support for amendments made as to why the amendment is made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL T. CHIN whose telephone number is (571) 272-6922. The examiner can normally be reached on MON-THURS (7:30 -6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EILEEN LILLIS can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Chin", with a stylized flourish at the end.

PAUL T. CHIN
Examiner
Art Unit 3652